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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,138	02/18/2004	Kevin Corcoran	ORM / 242US	3385

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WOOD, HERRON & EVANS, LLP
2700 CAREW TOWER
441 VINE STREET
CINCINNATI, OH 45202

EXAMINER	
PICKETT, JOHN G	
ART UNIT	**PAPER NUMBER**
3728	

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08/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/781,138	**Applicant(s)** CORCORAN ET AL.	
	Examiner Greg Pickett	**Art Unit** 3728	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 July 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: 7-32.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: See Continuation Sheet.

Continuation of 3. NOTE:
The proposed amendments to change the dependencies of claims 25 and 26 raises new issues that would require further consideration and/or search.

Continuation of 11. does NOT place the application in condition for allowance because:
Applicant's arguments are not persuasive.

With respect to the rejections in section 6: Applicant places a great deal of emphasis on the term "orthodontic appliance", yet the term is not defined in the specification to mean any particular structures. Although the specification does mention orthodontic brackets or braces, these are mentioned as exemplary, only. In using the broad term "appliance" instead of bracket or brace, applicant clearly intends to have the scope of the claims extend beyond brackets or braces. Accordingly, the claims have been examined using a very broad definition of the terms. Moreover the vials of Perfect are clearly used as an orthodontic appliance (Col. 3, lines 26-43) and are configured to be used for either the same tooth or different teeth.

With respect to the rejection in section 7: The appliances are not positively claimed. Brown is capable of holding "appliances" 38 & 34 in virtually any orientation, such as those depicted in Figure 1. Vertical is a predetermined, fixed orientation.

With respect to the rejections in section 8: Applicant uses the terminology "substantially identical" the degree of similarity is not defined in the specification. The brackets of Bozman have the same basic shape and may be considered "substantially identical" when considered broadly; they are capable of being placed on the same tooth. The recitation that an element is "configured for" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. Placement on the same tooth is an intended use limitation. The absence of a disclosure relating to the function does not defeat the finding of anticipation since it is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable. In re Schneller, 44 USPQ 2d 1429 (Fed Cir. 1997); In re Spada, 15 USPQ 2d 1655 (Fed. Cir. 1990); and In re Benner, 82 USPQ 49 (CCPA 1949).

With respect to the rejection in section 9: James discloses the claimed invention when considering the limitations broadly. The recess and cavities are clearly denoted in the rejection.

With respect to the rejections in section 10: Arguing that neither reference suggests the entire claimed invention is insufficient to overcome a rejection based on the combination of references. Chester teaches the tray, structure to restrict orientation of the brackets, and suggests a set-up tray. Georgakis teaches a set-up tray on a support in an organizer and restricts movement of the tray. The test for obviousness is what the combined teachings of the applied references, taken as a whole, would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) and In re McLaughlin, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

With respect to the rejections in section 11: Again, applicant has not defined "appliance". Brown is capable of holding "appliances" 38 & 34 in virtually any orientation, such as those depicted in Figure 1.

With respect to the rejections in section 12: The Chester-Georgakis combination is addressed above.

With respect to the rejections in sections 13 and 14: The James rejection is addressed above.

With respect to the rejection in section 15: The Bozman rejection is addressed above.

Continuation of 13. Other:
The proposed amendment to claims 13 and 29 would appear to overcome the objections to said claims if submitted in a separate, timely filed amendment. The proposed amendment to claims 19 and 22 would appear to overcome the rejections under 35 USC 112, 2nd paragraph if submitted in a separate, timely filed amendment.

/Greg Pickett/
Examiner
AU 3728